



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Mikio AOKI et al.

Group Art Unit: 2155

Application No.: 09/892,886

Examiner: M. WON

Filed: June 28, 2001

Docket No.: 109952

For: DATA OUTPUT CONTROLLER

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

After entry of the Notice of Appeal filed herewith, Applicants respectfully request review of the Final Rejection mailed March 25, 2005 in the above-identified application.

Claims 1-18 are pending in this application. No amendments are being filed with this request.

Applicants respectfully submit that claims 17 and 18 are not anticipated under 35 U.S.C. §102(e) by U.S. Patent No. 5,862,321 to Lamming et al. Lamming does not disclose "a device to print the information via the output terminal in more detail than the portable terminal," as recited in claim 17, and as similarly recited in claim 18.

Applicants also respectfully submit that claims 1-16 would not have been rendered obvious under 35 U.S.C. §103(a) by U.S. Patent No. 5,559,933 to Boswell in view of U.S. Patent No. 6,259,405 to Stewart et al. Claims 1-16 claims would not have been rendered obvious by any permissible combination of Boswell and Stewart, because neither reference teaches or suggests a data output controller that includes "the selecting device retrieving output

terminal information from the storage device on the basis of the search data contained in the data print request and on the basis of a capability of the data format converting device so as to select an output terminal considered to be the best suited for the user of the portable terminal to receive provided output data," as recited in claim 1, and as similarly recited in claim 9.

I. Claims 17 and 18 are not anticipated by Lamming.

For at least the reasons discussed below, in addition to the reasons set forth in the June 23, 2005 Amendment After Final Rejection, claims 17 and 18 are not anticipated by Lamming.

An Advisory Action mailed July 19, 2005 rebuts Applicants' argument set forth in the June 23, 2005 Amendment After Final Rejection and asserts that because the portable device of Lamming displays a document icon and prints the actual electronic document, Lamming therefore discloses "a device to print the information via the output terminal in more detail than the portable terminal," as recited in claims 17 and 18.

However, "the information displayed on the display device" of Lamming is not the information printed ("the information in more detail"). Thus, Lamming does not disclose "a device to print the information via the output terminal in more detail than the portable terminal," as recited in claim 17, and as similarly recited in claim 18.

II. Claims 1-16 would not have been rendered obvious by Boswell in view of Stewart.

For at least the reasons discussed below, in addition to the reasons set forth in the June 23, 2005 Amendment After Final Rejection, claims 1-16 would not have been rendered obvious by Boswell in view of Stewart.

The Advisory Action rebuts Applicants' arguments set forth in the June 23 Amendment After Final Rejection and newly asserts that Boswell discloses the selecting device recited in independent claims 1 and 9. Specifically, the Advisory Action argues that it is inherent that

Boswell teaches a selecting device that also retrieves output terminal information on the basis of a capability of the data format converting device. See, e.g., Boswell, col. 2, lines 26-27; col. 2, lines 56-58; col. 3, lines 55-60; and col. 7, line 66 - col. 8, line 3.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, "in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

However, the Examiner has provided no such factual and/or technical reasoning to reasonably support that Boswell inherently discloses the claimed selecting device. Nowhere does Boswell teach or suggest "a data format converting device that converts the output data into a format according to the output terminal information," as recited in claim 1, and as similarly recited in claim 9. Thus, Boswell does not disclose "the selecting device retrieving output terminal information from the storage device on the basis of the search data contained in the data print request and on the basis of a capability of the data format converting device so as to select an output terminal considered to be the best suited for the user of the portable terminal to receive provided output data," as recited in claim 1, and as similarly recited in claim 9.

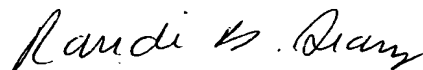
Further, Stewart does not cure the deficiencies of Boswell discussed above. Stewart is cited in the June 23 Amendment After Final Rejection merely for disclosing a portable user terminal.

III. Conclusion

For at least the reasons discussed above, and the reasons set forth in the June 23 Amendment After Final Rejection, claims 17 and 18 are not anticipated by Lamming, and claims 1 and 9, and claims 2-8 and 10-16 depending therefrom respectively, would not have rendered obvious by Boswell and Stewart. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-18 are earnestly solicited.

Respectfully submitted,



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Attachment:
Notice of Appeal

Date: July 25, 2005

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